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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,566	02/04/2004	Amy B. Howell	78687-128	5105
26259	7590	11/07/2005		
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			EXAMINER SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/772,566

Applicant(s)

HOWELL ET AL.

Examiner

Taofiq A. Solola

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-13, 20-51 and 53-90 is/are pending in the application.
- 4a) Of the above claim(s) 20-50 and 53-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-13 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____.  |

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Claims 1-13, 20-51, 53-90 are pending in this application.

Claims 14-19, 52 are cancelled.

### ***RESTRICTION REQUIREMENT***

In response to the Restriction Requirement, Applicant elects group I, claims 1-13, 51, with traverse. The traversal is on the basis that groups I and IV "overlap in their classification" and therefore the restriction should be withdrawn. This is not persuasive because overlap classification is not a sufficient basis for determining restriction requirement. In fact, it would be undue burden for the Examiner to search all the groups. However, if the elected invention is found in condition for allowance the Rule of Rejoinder would be applied. Therefore, the restriction is still deemed proper and made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "about seven", line 2, implies a range between 6.5 and 7.4. It is not possible for epicatechin flavanoid monomer unit to exists in fractions. Therefore, the claim is indefinite. Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v.*

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*Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13, 51 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,608,102. This is a double patenting rejection.

The claims are drawn to compositions of the same active compounds from the same source and for the same utility. The instant claims cite the plant sources of the active compounds, that it is substantially purified, capable of inhibiting P-type *E.coli* and not capable of inhibiting type I *E.coli*. However, intended use is not a limitation of a compound or product. *In re Hack*, 114 USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). In application 90/145,694, which matured into US 6,608,102 (US '102) and the instant application, the specifications read:

**The present invention is directed to isolation and identification of plant proanthocyanidin extracts. These extracts can be obtained from any of a variety of proanthocyanidin-containing plants including members of the plant families Ericaceae, Rosaceae, Pinaceae and Vitaceae, and preferably are from cranberry plants (especially *Vaccinium macrocarpon*), other *Vaccinium* spp. and grapes (*Vitis* spp.) These extracts are useful for prevention and treatment of urinary tract infections caused by P-type fimbriated *Escherichia coli* as well as other uses. Extracts containing proanthocyanidins with A-type interflavonoid bonds have been found to have potent bioactivity for inhibiting adherence of P-type *E. coli*.**

Also, the declaration filed by Dr. Howell on 1/11/01, during prosecution of 09/145,694, reads:

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The proanthocyanidin extracts prepared by the methods disclosed in my patent application are purified preparations of proanthocyanidins which are substantially free of anthocyanins and flavonols, contain proanthocyanidin compounds with at least one A-type linkage within the molecules and possess bacterial anti-adherence activity against P-fimbriated bacteria, not against type 1-fimbriated bacteria.

In conclusion, is it clear from the above passages that the instant claims and that of US '102 are drawn to the same subject matter, semantics notwithstanding.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, J.D. whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

November 2, 2005